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REMARKS

This amendment is presented in response to the office action mailed April 27, 2006. Applicant requests favorable reconsideration and allowance of all claims in the application.

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DRAWINGS

The office action objected to the drawings. The specification has been amended to correct two minor clerical errors, and in view of this, the drawings no longer present any objectionable material. No new matter has been added.

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35 USC 112 REJECTION: CLAIMS 1, 7, 13

These claims were rejected under 35 USC 112, second paragraph, as being incomplete for omitting essential steps, "such omission amounting to a gap between the steps." [Office Action: page 3] There was said to be a gap between the providing / monitoring / communicating / updating operations and the searching operation. In this regard, the Examiner assumed that "a member submits a query request to the aggregated catalog, to which a response is issued, where searching the aggregated catalog is performed." [Office Action: page 3]

20

Applicant respectfully traverses the present rejection. The office action repeated the claim language and averred that there is gap between operations. Other than the statement that there is "a gap between the two steps", the office action did not contain any substantive explanation of the nature of this gap, or why the gap is objectionable. In this regard, the office action is incomplete.

25

Nonetheless, in the example of claim 1, the original claim language specifies that the "searching" operation is performed "responsive to each request by a member," which would seem to resolve the confusion expressed in the office action.

30

Applicant objects, to the extent the office action incorrectly reads unintended limitations into the claim concerning "a member submits a query request to the aggregated catalog." Such limitations, performed by a member,

are improperly read into this claims. In the case of claim 1, the claim concerns "a method for operating an online service facility," and any reading requiring any actions be performed by members to satisfy the claim language would be improper and unduly narrow.

5 Applicant requests withdrawal of the 35 USC 112 rejection of claims 1, 7, 13.

35 USC 112 REJECTION: CLAIM 13

10 This claim was rejected under 35 USC 112, second paragraph, as being an improper means plus function claim. [Office Action: page 4] The office action stated that "no function is specified by the word(s) preceding means", and it is therefore impossible to determine the equivalents of the element. [Office Action: page 4]

15 Applicant respectfully traverses this rejection. Claim 13 is fully compliant with 35 USC 112 (sixth paragraph) because (1) the claim limitations use the phrase "means for," (2) the "means for" is modified by functional language, and (3) the phrase "means for" is not modified by sufficient structure, material or acts for achieving the specified function. MPEP 2181. Taking the "aggregated catalog means" as an example:

- 20 1. This language includes the phrase "means for", and namely, "aggregated catalog means for storing information..."
2. The "means for" is modified by functional language, namely, means for "storing information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata
- 25 identifying members' data objects residing in local storage of respective member computers."
3. The "means for" phrase is not modified by significant structure, material, or acts for achieving the specified function.

30 The inclusion of words preceding "means" is intended as an aid to clearly and concisely identifying an antecedent means element, and comply with the intent of 35 USC 112. This language does not meaningfully narrow or confuse the claim

language at all. To the same effect, the means clauses of claim 13 could have been named first means, second means, and so on, with the preceding words "first" and "second" included merely to aid legibility of the claim. As specifically contemplated by MPEP 2181, 35 USC 112 accommodates a variety of different means plus function formats.

Applicant requests withdrawal of the 35 USC 112 rejection of claim 13.

35 USC 101 REJECTION: CLAIMS 1, 17, 13

The office action rejected these claims as being directed to non-statutory subject matter. Applicant respectfully traverses the rejection. The claims are patentable under section 101 since the Examiner has not set forth a *prima facie* case of unpatentability, as required.

As the Supreme Court held, Congress chose the expansive language of 35 USC 101 to include "anything under the sun that is made by man."¹ "The plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103 and 112. The use of the expansive term 'any' in section 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35... Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations."²

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture, or composition of matter). In many instances it is clear within which

¹ *Diamond v. Chakrabarty*, 447 US 303, 308-309, 206 USPQ 193, 197 (1980).

² *In re Allapat*, 33 F.3d 1526, 1542, 31 USPQ2d 1545, 1556 (Fed. Cir. 1994)

of the enumerated categories a claimed invention falls.³ In the present case, claim 1 concerns a process ("method"), claims 7/13 concern machines ("data management equipment").

5 Nor do the claims fall within judicial exceptions to section 101, such as abstract ideas, natural phenomena, and laws of nature. Clearly, the claims are rife with real word details of practical application, such as online data centers, member computers, catalogs, metadata, storage of data objects, providing an output for display at a member computer, etc.

10 Accordingly, the claims are fully compliant with 35 USC 101, and concern abundantly statutory subject matter.

Although the office action's line of reasoning is not fully comprehended, the office action proposes that "a signal bearing medium is not tangible, and cannot tangibly embodying a computer program or process." "A computer cannot understand/realize (i.e., execute) the computer program of process when embodied on the data signal." [Office Action: page 5] In this regard, the office action suggests that a data signal does not meet the "useful, concrete, and tangible" requirement. [Office Action: page 5]

20 First, Applicant disputes this suggestion. From a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.⁴ There has been no citation of proper legal authority to suggest otherwise.

25 Second, even if (for the sake of argument) a data signal does not meet the "useful, concrete, and tangible" requirement, this is irrelevant to the claims. The "data signal" or a "signal bearing medium" subject matter is unrelated to the claims at issue. Rather, the claims are clearly aimed at a statutory process (i.e., a method) or a statutory machine (i.e., data management equipment). In the

³ USPTO Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility

⁴ *Id.*

case of claim 7, the subject matter includes an aggregated catalog, an aggregator (programmed to perform certain operations), and a finder (programmed to perform certain other operations). If a machine is programmed in a certain new and unobvious way, "it is physically different from the machine without that program; its memory elements are differently arranged. The fact that these physical changes are invisible to the eye should not tempt us to conclude that the machine has not been changed. If a new machine has not been invented, certainly a 'new and useful improvement' of the unprogrammed machine has been, and Congress has said in 35 U.S.C. 101 that such improvements are statutory subject matter for a patent."⁵

Moreover, the office action admits that "while communicating with the member computers, a transmission of data occurs, where the prescribed types of data are transmitted from the member computer's local storage to the on-line data centers." [Office Action: page 4] Transmission of data from a member computer's local storage to an on-line data center is clearly statutory subject matter, undercutting any argument that the claims are nonstatutory.

As such, claims 1, 7, 13 are patentable as-is, because the rejection of claims 1, 7, 13 does not constitute a *prima facie* case of unpatentability as required. Applicant requests withdrawal of the 35 USC 101 rejection of claims 1, 7, 13.

35 USC 103 REJECTIONS: CLAIMS 1, 3-4, 6-7, 9-10, 12-13

These claims were rejected under 35 USC 103 as being unpatentable over the combination of U.S. Patent No. 6,804,674 to Hsiao et al. ("Hsiao") and U.S. Patent No. 6,878,384 to Johnson et al. ("Johnson '384"). This rejection is respectfully traversed. The claims are patentable since a *prima facie* case of obviousness does not exist, as discussed in greater detail below.⁶

Teaching/Suggestion of Claim Limitations

⁵ *In re Bernhart and Fetter*, 163 USPQ 611 (CCPA 1969).
⁶ MPEP 2142.

First, the *prima facie* obviousness case is incomplete because, even if the references were to be combined as suggested (albeit improperly, as discussed below), the combination still does not teach or suggest all the claim limitations.⁷

To support the conclusion that the claimed invention is directed to obvious
5 subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.⁸

All words in a claim must be considered in judging the patentability of that
10 claim against the prior art.⁹ Taking claim 1 as an example, the proposed combination of references fails to teach the following combination:

A method for operating an online service facility selectively accessed by
15 multiple member computers, the online service facility including a plurality of online data centers operated by an online service provider (OSP) to store members' data objects relating to a variety of online services that the OSP renders to its members, the method comprising operations of:

providing an aggregated catalog that contains information including:

20 (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying members' data objects residing in local storage of respective member computers;

monitoring contents of the data centers to detect new storage of
25 prescribed types of data objects owned by the members;

30 communicating with the member computers to identify prescribed types of data objects newly stored in the member computers' local storage;

updating the aggregated catalog to list the newly stored data
objects from the online data centers and member computers' local storage;

responsive to each request by a member, searching the
aggregated catalog and utilizing results of the search to
provide an output for display at the requesting member's
computer, the output comprising a consolidated listing of

7 MPEP 2142, 2143.03.

8 *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP 706.02(j).

9 *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

both online data objects and locally stored data objects owned by the requesting member.

As a more particular example, claim 1 is patentably distinguishable from the applied art because the applied art does not show the claimed combination including "providing an aggregated catalog that contains information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying members' data objects residing in local storage of respective member computers."

The office action proposes that this feature is found in Hsiao's col. 10, lines 49-53. [Office Action: page 7] However, Hsiao does not teach "metadata identifying members' data objects residing in local storage of respective member computer" as claimed.

Hsiao's Figure 1 is said to show an exemplary overall environment in which a scalable content management system 10 of the present invention may be used. [Hsiao: col. 8, lines 17-19] In Hsiao's Figure 1, users, such as remote Internet users are represented by a variety of computers such as computers 37, 39, and can query a content management system 10 for the desired information. [Hsiao: col. 8, lines 32-35; Fig. 1] However, Hsiao fails to disclose any members' data objects residing in local storage of users' computers such as 37, 39. Nor is there any discussion of an aggregated catalog containing information about such data objects.

Hsiao's Figure 2 is said to show an exemplary high level architecture showing the scalable content management system of Figure 1 used in the context of an Internet search. [Hsiao: col. 8, lines 49-51] Although Hsiao's Figure 2 purportedly shows a user's web browser, there is no discussion of any data objects residing in local storage of the user's computer where the web browser is installed. Nor is there any discussion of an aggregated catalog containing information about such data objects.

Hsiao's Figure 4 is said to show a process of using a scalable content management system. [Hsiao: col. 9, lines 58-61] Although Hsiao's step 405 purportedly illustrates a search for documents, and step 410 shows a search of

metadata and file system, there is no teaching that the search includes any data objects residing in local storage of respective member computers.

Similarly, Hsiao's Figure 5 is said to show a block diagram representation of the scalable content management system, where the scalable content management system 10 provides connectivity to a client 505, such as a web client or an end user, who is connected to the service provider 100 (FIG. 2) via the network 20. [Hsiao: col. 10, lines 23-28] Although Hsiao's Figure 5 shows various clients (such as a web client or an end user), there is no illustration or discussion of data objects residing in local storage of the user's computer where the web browser is installed. Nor is there any discussion of an aggregated catalog containing information about such data objects.

Hsiao suggests that its eContent manager is a building block that can be used to build a personal content manager on a small home PC. Alternatively, Hsiao mentions that the eContent manager may be implemented in a highly powered and highly scalable web and/or enterprise content server. [Hsiao: col. 4, lines 12-19] Nevertheless, Hsiao does not suggest combining the personal content manager with the enterprise content server, nor does Hsiao illustrate any mechanism for doing so.

Although Hsiao makes mention of a local content manager and a plurality of remote content managers, both local and remote content managers are part of the network-accessible content management system 10. [Hsiao: col. 8, lines 17-48] Moreover, Hsiao's parallel query manger 615 must combine the local search results from the content search and parametric search, if both exist; the manager 614 may also be awaiting the remote search results from the remote content managers 650. In case of remote search results, both the local and the remote search results 655 are merged or appended, and returned to the user. [Hsiao: col. 12, lines 5-10] This is inconsistent with (and teaches away from) an aggregated catalog, as claimed.

Accordingly, Hsiao does not teach the claimed operation of "providing an aggregated catalog that contains information including: (1) metadata identifying members' data objects residing in the data centers, and (2) metadata identifying

members' data objects residing in local storage of respective member computers."

The office action admits that Hsiao lacks the claimed operation of "monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members." [Office Action: page 8] Instead, the office action proposes that this feature is found in the Abstract of Johnson '384. [Office Action: page 8] However, Johnson is focused at monitoring inbound and outbound information activity at the household level, such as monitoring real-time interaction between an on-line service and a household to reveal information about the type of information being accessed or the time of day a particular service is accessed. [Johnson '384: col. 2, lines 36-41] Johnson seeks to monitor and collect inbound/outbound information activity and communications activity at a particular user location, such as a household equipped with a variety of devices having communications capabilities. [Johnson '384: col. 2, lines 57-62] Johnson '384 is said to collect information concerning user operation of a software package, such as the time of loading the software package, total usage time of the application, types of files accessed or types of functions accessed by the user. [Johnson '384: col. 2, lines 43-51]

Johnson '384 is therefore focused on the household, rather than contents of online data centers as claimed. And, although Johnson '384 specifically discusses various types of information activity mentioned above, Johnson '384 falls to mention "new storage of prescribed types of data objects owned by the members" as claimed. Accordingly, Johnson '384 does not teach the claimed feature "monitoring contents of the data centers to detect new storage of prescribed types of data objects owned by the members."

The applied art also lacks the claimed operation of "communicating with the member computers to identify prescribed types of data objects newly stored in the member computers' local storage." As discussed in detail above, Hsiao does not contemplate data objects stored on member's computers.

The applied art also lacks the claimed operation of "updating the aggregated catalog to list the newly stored data objects from the online data

centers and member computers' local storage." The office action proposes that this feature is found in Hsiao's col. 3, lines 21-15 and col. 4, lines 51-54. [Office Action: page 7] However, the office action already admits that Hsiao does not teach "monitoring contents of the data centers to detect new storage of

5 prescribed types of data objects owned by the members." For reason, Hsiao necessarily fails to show "updating the aggregated catalog to list the newly stored data objects from the online data centers..." In fact, as also discussed above, Hsiao teaches away from the claimed aggregated catalog by teaching a completely different approach.

10 The applied art also lacks the claimed operation of "responsive to each request by a member, searching the aggregated catalog and utilizing results of the search to provide an output for display at the requesting member's computer, the output comprising a consolidated listing of both online data objects and locally stored data objects owned by the requesting member." As mentioned
15 above, the applied art does not teach the claimed aggregated catalog, so the operation of "searching the aggregated catalog..." is similarly missing from the art.

In view of the foregoing, the features of claim 1 are absent from Hsiao and Johnson '384. Further, for similar reasons, independent claims 7 and 13 are
20 patentably distinguished from the applied art. And, even without considering any individual merits of claims 3-4, 6, 9-10, and 12, these claims are distinguished from the applied art because they depend from independent claims that are distinguished as discussed above.¹⁰ Nonetheless, as an example of certain features of these dependent claims that further distinguish over the applied art,
25 claims 4 and 10 are discussed. Namely, the applied art fails to show "during display of the consolidated listing at the member's computer, updating the display substantially in real time to reflect any data objects that are of prescribed types, owned by the member, and newly stored in the online data center during the

¹⁰ If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

display." The office action proposes that the features of claims 4, 10 are found in Johnson '384. [Office Action: page 9] As discussed in detail above, however, Johnson '384 is focused on the household, rather than contents of online data centers as claimed. Furthermore, Johnson '384 does not demonstrate any
5 concern with "new storage of prescribed types of data objects owned by the members" as claimed.

Moreover, Johnson '384 does not show "display of the consolidated listing at the member's computer" and "updating the display substantially in real time..." as claimed. Again, Johnson '384 is concerned with market research, and
10 particular monitoring user activity, such as capturing data regarding household purchases or access of product or market data from electronic sources. [Johnson '384: col. 2, lines 24-31] From this standpoint, it does not make sense why Johnson '384 would display such information about the user at the user's computer. Johnson '384's household information is clearly collected for use and
15 display by entities other than the household user him/herself. Accordingly, for a number of reasons Johnson '384 does not teach the claimed feature "display of the consolidated listing at the member's computer" and "updating the display substantially in real time..." as claimed.

20 Suggestion or Motivation

In addition to the reasons given above, the *prima facie* obviousness case is also defective because there has been no suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference
25 teachings.¹¹

The office action suggests that it would have been obvious to modify Hsiao with the teachings of Johnson '384 "to include a method for monitoring contents of the data centers to detect new storage of prescribed types of data

¹¹ MPEP 2142.

objects owned by the members." This suggestion is untenable because, as mentioned above, Johnson '384 does not teach this feature.

As motivation to make the suggested combination, the office action cites a desire to "provide the functions needed for content creation, storage, search, management, and distribution." [Office Action: page 9] However, according to Hsiao, the "scalable content management system of the present invention provides several functions, among which are the following... a single scalable content manager will provide the functions needed for content creation, storage, search, management, and distribution." [Hsiao: col. 4, line 56 – col. 5, line 15]

Therefore, according to Hsiao's own disclosure, Hsiao's already satisfies the need identified in the office action. Lacking from the references is any motivation to modify Hsiao's system by incorporating any features from Johnson '384. The office action's purported motivation merely suggests using Hsiao's system as taught by Hsiao.

Accordingly, the *prima facie* case of obviousness is lacking since there has been no showing of the legally required suggestion or motivation to modify the reference or to combine reference teachings.

Reasonable Expectation of Success

In addition to the reasons stated above, the *prima facie* obviousness case is further defective because the office action failed to show that there would be a reasonable expectation of success in modifying/combining references.¹² The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.¹³ If the examiner does not produce a *prima facie* case, the applicant is under *no* obligation to submit evidence of nonobviousness.¹⁴ Critically, to establish a *prima facie* case of obviousness,

¹² MPEP 2142, 2143.02.

¹³ MPEP 2142.

¹⁴ *Id.*

there must be a reasonable expectation of success.¹⁵ This reasonable expectation of success must be found in the prior art, not in Applicant's disclosure.¹⁶

5 The office action lacks any evidence, allegation, or other mention of the legally required "reasonable expectation of success." Accordingly, the *prima facie* case of obviousness is incomplete.

Conclusion as to Claims 1, 3-4, 6-7, 9-10, 12-13

10 As shown above, then, these claims are patentable since a *prima facie* case of obviousness does not exist. Namely, (1) the applied art fails to teach the features of the claims, (2) there is insufficient motivation to combine/modify references as proposed by the office action, and (3) there is no showing that an ordinarily skilled artisan would have a reasonable expectation of success in making the office action's proposed modification of references.

15

35 USC 103 REJECTIONS: CLAIMS 2, 8

20 Claims 2, 8 were rejected under 35 USC 103 as being unpatentable over the combination of Hsiao, Johnson '384, and U.S. Patent No. 5,805,858 to Kumamoto et al. ("Kumamoto"). Even without considering the individual merits of these claims, they are patentably distinguished over the proposed combination because they depend from independent claims that are allowable over Hsiao and Johnson '384 (as discussed above), and Kumamoto fails to provide the features missing from Hsiao and Johnson '384. For instance, in the example of claim 1, Kumamoto still does not show the claimed combination including operations of
25 "providing an aggregated catalog..." "monitoring contents of the data centers..." or "communicating with member computers.." or "updating the aggregated catalog..." or "searching the aggregated catalog..." as discussed above. Instead,

¹⁵ MPEP 2143.

¹⁶ *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). MPEP 2143.

the office action introduced Kumamoto simply to show a member-activated VIEW feature. [Office Action: page 10]

35 USC 103 REJECTIONS: CLAIMS 5, 11

- 5 Claims 5, 11 were rejected under 35 USC 103 as being unpatentable over the combination of Hsiao, Johnson '384, and U.S. Patent No. 5,964,839 to Johnson et al. ("Johnson '839"). Even without considering the individual merits of these claims, they are patentably distinguished over the proposed combination because they depend from independent claims that are allowable over Hsiao and
- 10 Johnson '384 (as discussed above), and Johnson '839 fails to provide the features missing from Hsiao and Johnson '384. For instance, in the example of claim 1, Johnson '839 still does not show the claimed combination including operations of "providing an aggregated catalog..." "monitoring contents of the data centers..." or "communicating with member computers.." or "updating the
- 15 aggregated catalog..." or "searching the aggregated catalog..." as discussed above. Instead, the office action introduced Johnson '389 simply to show a monitoring operation carried out by communicating with data centers to identify data objects contained therein. [Office Action: page 12]

CONCLUSION

In view of the foregoing, all pending claims in the application are patentable over the applied art.

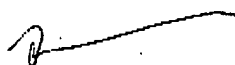
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FEES

If any fees are required by this submission, an appropriate fee submittal sheet is enclosed herewith. If fees are required yet this sheet is inadvertently missing, or the fees are incorrect in amount, please charge the charge the required fees (or credit any overpayment) to Deposit Account No. 07-1445.

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Respectfully Submitted,



15

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